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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/340,566	06/28/99	TURK J	01929-P0001E

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EXAMINER	
ROMAIN, J	
ART UNIT	**PAPER NUMBER**
2765	3

DATE MAILED: 04/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/340,566	Turk et al.
Examiner	**Group Art Unit**
Romain Jeanty	2765

☒ Responsive to communication(s) filed on *Jun 28, 1999*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *12-15* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *12-15* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on *Aug 9, 1999* is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☑ Information Disclosure Statement(s), PTO-1449, Paper No(s). *4*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). Applicant is advised to submit drawing sheet(s) featuring the claimed invention. Applicant is reminded that each and every claim element must be found in the drawings as required by 37 CFR 1.83(a) and also the drawings and specification must describe, show and correspond for all components shown or discussed as required by 37 CFR 1.84(p). The drawings must show every feature of the invention specified in the claims. Therefore, all means and elements claimed must be shown and supported in the figures or the features canceled from the claims. This means where structure is claimed, be it in method or apparatus type claims, such structure must be clear as to its intended meaning and correspondence with the elements in the drawings. All method steps are considered "elements" or "features" of claims and also must find support in the figures. Software or programs per se cannot be relied upon as support for means or structure claimed, because such are not structure as these type limitations require. The various claimed functions are not seen supported by specific structure. If support exists in the drawings and written specification, this support should be pointed out so that it is clear on the record what applicant intend these various means-plus-function to cover and the basis in the written specification for what their alternative equivalents are. Therefore, the means for "an electronic coin", "a storage for the electronic coin", a "date representing when the electronic coin was created" and "a digital signature for verifying the electronic coin" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 12-15 are rejected under the judicially created doctrine of double patenting over claims 1-5 of U. S. Patent No. 5,983,207. Although the conflicting claims are not identical, they are not patentably distinct from each other. It would have been obvious to those in possession of the invention defined by claims 1-5 of the U.S Patent No. 5,983,207 to utilize a Digital Hallmark as described in the abstract and in various parts of the specification. Those in possession of the present invention would have been motivated to create a Digital Hallmark in order to authenticate the electronic coin thereby preventing invalidated coins from being used when making transactions. Since the omission or addition of the cited limitations would have not changed the

process according to which functional differences are compensated for in the distributed system environment. Further, it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. ***In re Karlson, 136 USPQ 184 (CCPA 1963)***.

Claim Rejections - 35 U.S.C. § 112

4. Claims 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13-14, it appears that these claims should depend on the base claim 12.

Claim 15 recites the limitation "said precious metal". There is insufficient antecedent basis for this limitation in the claim. It appears this claim 15 should depend on claim 14.

Claim Rejections - 35 U.S.C. § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 12-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically, as directed to an abstract idea.

Claims 12-15 are rejected under 35 U.S.C. § 101 because they are directed to non-statutory subject matter, specifically, as directed to an abstract idea.

Data Structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory

processes. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the medium which permit the data structure's functionality to be realized, and is statutory. Thus, the claims are rejected as being non-statutory as described above.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached on weekdays from 8:00 a.m to 4:30 p.m.

If attempts to reach the examiner are not successful, the examiner's supervisor, Allen R. MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703)308-3900.

Romain Jeanty.

March 20, 2000.

ERIC W. STAMBER
PRIMARY EXAMINER